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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Inventors: Naoyasu MIYAGAWA, et al.

Art Unit: 2655

Appln No.: 10/693,810

Examiner: N. Hindi

Filed: October 23, 2003

Confirmation No. 7820

For: OPTICAL RECORDING/REPRODUCING APPARATUS FOR OPTICAL
DISKS WITH VARIOUS DISK SUBSTRATE THICKNESS

RESPONSE

The Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

Reconsideration and allowance are respectfully requested in
view of the following comments.

A Supplemental Reissue Declaration is attached, as required in
the office action.

Claims 25-28 stand rejected under 35 U.S.C. §251 as being an
improper recapture of broadened claimed subject matter, citing
Hester Industries, Inc. v. Stein, Inc. 142 F. 3d 1472, 46 USPQ
2d 1641 (Fed. Cir. 1998), *In re Clement*, 131 F. 3d 1448, 45 USPQ
2d 1161 (Fed. Cir. 1997), *Ball Corp. v. United States*, 729 F. 2d
1429, 221 USPQ 289 (Fed. Cir. 1984) and *Pannu v. Storz
Instruments Inc.*, 258 F. 3d 1366, 59 USPQ 2d 1597 (Fed. Cir.
2001). However, the office action completely overlooks the 2003

decision of an expanded panel of the Board of Patent Appeals and Interferences in *Ex parte Eggert et al.*¹ which (1) explains the *Hester*, *Clement*, *Ball* and *Pannu* decisions and (2) is binding precedent on the examining corp so as to control all proceedings within the United States Patent and Trademark Office with regard to the issue of recapture. The office action asserts an interpretation of the above Federal circuit decisions that is completely contrary to (1) *Ex parte Eggert et al.*, a copy of which is provided herewith for convenience and (2) the current version of MPEP 1412 which takes into account *Eggert et al.*.

The central argument in the Office Action is that, if there is a broadening aspect that relates to surrendered subject matter, then *per se* the reissue claim is barred by the recapture rule.

However, this *per se* approach has been expressly condemned in *Eggert et al.* As noted by the Board, a *per se* rule is contrary to express statements in *Clement* and *Pannu*, and the Federal Circuit has never held that germane broadening is a *per se* violation of the recapture doctrine.

Eggert et al. clarified what constitutes surrendered subject matter and what is to be the focus in determining germane

¹Appeal No. 2001-0790, May 29, 2003. Hereinafter, "*Ex parte Eggert et al.*" or "*Eggert et al.*" refers to this decision and not the earlier board decisions also involving *Eggert et al.*

broadening and narrowing. The Board stated that the canceled claim constitutes surrendered subject matter, but the subject matter intermediate of the canceled and the issued claim does not. *Ex Eggert et al.*, page 5. The Board stated that the focus should be the claim from which the issued claim directly evolved, not the issued claim itself. *Infra*, page 6.

The Board stated that a rigid *per se* rule is not consistent with the remedial nature of the reissue statute and is not supported by the legal precedent of the Federal circuit. *Infra*, page 14. In practical effect, such a *per se* rule would negate the broadening reissue statute (35 USC 251) with respect to claims amended or argued to gain patentability over the prior art, as well as possibly claims allowed on first action but subject to an examiner's reasons for allowance in the notice of allowability. In other words, under such a rule virtually all broadening reissues would be precluded. If this *per se* rule were to prevail, the reissue statute would be of very little practical value, given that virtually all cases undergo claim amendments, arguments for allowance or examiner's reasons for allowance during prosecution.

In *Eggert et al.*, the Board cited the following portion of *Clement*:

Once we determine that an applicant has surrendered the subject matter of the canceled or amended claim, we then determine whether the surrendered

subject matter has crept into the reissue claim. Comparing the reissue claim with the canceled claim is one way to do this. If the scope of the reissue claim is the same as or broader than that of the canceled claim, then the patentee is clearly attempting to recapture surrendered subject matter and the reissue claim is, therefore, unallowable. In contrast, a reissue claim narrower in scope escapes the recapture rule entirely. *In re Clement* at 1469, 45 USPQ2d at 1164.

Further, the Board noted that *Clement* and *Pannu* clearly leave open the possibility that reissue claims which have been broadened in an aspect related to surrendered subject matter may avoid the recapture rule if they are materially narrowed in other respects. *Infra*, page 28. The Board stated that the proper inquiry requires a fact-specific analysis in each case to determine whether the patentee is attempting to recapture surrendered subject matter, in accordance with the basic test of *Clement*. *Infra*, page 31.

On page 6 of its decision, the Board provided a concentric circle diagram to assist in recapture analysis. The Board stated:

For example, if an outer circle claim contains elements ABC and the inner circle claim contains elements ABCDEF, a reissue applicant cannot recapture a claim directed to elements ABC (outer circle) or a claim entirely outside the outer circle (e.g., AB, BC, ABC_{BR2}, etc.). However, it is our view that the reissue recapture rule is not invoked for claims directed to elements ABCX, ABCD_{BR}, ABCEF, A_{BR}BCDEF. In other words, the focus for determining the reach of the reissue recapture rule should be the claim from which the issued claim directly evolved, not the issued claim

itself. We believe that this is where we and the members of the dissent disagree. *Infra*, page 6.

The Board recognized that recapture is avoided in some circumstances where the reissue claims are materially narrowed in respects other than those in which the reissue claims are broadened. Further, the Board recognized that recapture does not exist when the reissue claims are materially narrower in *overlooked aspects* of the invention and that the patentee may obtain through reissue a scope of protection to which he is rightfully entitled for such *overlooked aspects*. *Infra*, page 29.

Following the *Clement* test, the Board in *Eggert et al.* applied a three step analysis as follows:

First, the Board compared the reissue claims with the patent claims to determine whether and in what "aspect" the reissue claims are broader than the patent claims.

Secondly, having determined that the reissue claims have been broadened relative to the patent claims, the Board next determined whether those broadenings relate to surrendered subject matter.

Thirdly, the Board compared the rejected reissue claims to the surrendered subject matter to determine in what aspects the reissue claims are broader than the surrendered subject matter and in what aspects the reissue claims are narrower than the surrendered

subject matter, with the surrendered subject matter being the claim prior to the amendments resulting in its allowance.

Applying this three step analysis, the present claims directed to a signal processing circuit used for an optical disc apparatus recite overlooked aspects of the invention that were never claimed in the original application. For example, claim 25 recites a discriminating signal generator, connected with the optical detector, for generating a disc discrimination signal indicating the one of the types of optical discs; and a controller for controlling a light source driving circuit, for controlling a plurality of light sources, to selectively activate one of the light sources according to the disc discrimination signal. Claim 26 recites a discriminating signal generator for discriminating the types of optical discs by using the electric signal and generating a discrimination signal indicating the one of the types of optical discs. Claim 27 recites that the electric signal of claim 26 is a tracking error signal. Claim 28 recites a light source driving circuit for controlling emission of a light source; a focusing control circuit for controlling a focus of a converging section for converging a light beam emitted from the light source; an optical detector for detecting a light beam reflected on the information layer via the transparent layer; a tracking control circuit for controlling a tracking of the light beam converged by the

converging section; and a digital signal processing circuit for modulating and/or demodulating the signals to be recorded and/or reproduced, the signal processing circuit comprising a discriminating signal generator, connected with the optical detector, for generating a disc discrimination signal indicating one of the types of optical discs; and a controller for controlling switching an input signal or an output signal of at least one of the light source driving circuit, the focusing controlling circuit, the tracking control circuit, and the digital signal processing circuit. The above-noted features of the pending claims constitute distinctive elements not recited in the original claims. Thus, the Appellants are entitled to obtain the present reissue claims which are directed to overlooked subject matter in the original application.

These overlooked aspects are sufficient to avoid recapture estoppel.

Further, there is no surrendered subject matter based on the precedential CCPA decision in *In re Wesseler*, 367 F.2d 838, 151 USPQ 339 (CCPA 1966). The CCPA's decision in *Wesseler* is binding legal precedent. *Wesseler* held that there is no surrender based on a prior art rejection, where the canceled claims were subject to both an indefiniteness rejection and a prior art rejection and the record contains nothing to indicate cancellation, amendment or

argument to overcome the prior art rejection. Under *Wesseler*, if there is both a 35 USC 112 rejection and a prior art rejection and the record contains nothing to indicate cancellation, amendment or argument to overcome the prior art rejection, there is no surrender based on a prior art rejection. *In re Clement* reiterates that in reissue recapture, surrender requires cancellation, amendment or argument for the purpose of overcoming a prior art rejection.

The facts underlying the present application are virtually identical in pertinent point to those described by the court in *Wesseler*. Prior to the cancellation of claims in the original patent application for both *Wesseler* and the present case, all claims stood rejected as being vague and indefinite. Also, in *Wesseler*, claims 11, 12, 20, and 21 of the patent application were rejected as unpatentable over a patent to Simmonds, and in the present case, claims 1 and 6 were rejected over prior art. In *Wesseler* and the present case, the PTO alleged improper recapture. Also, in both *Wesseler* and the present case, the PTO alleged, either expressly or impliedly, that the Applicants had acquiesced to the rejection made by the examiner in the parent application and thus surrendered the subject matter of the cancelled claims.

Applying *Wesseler* to the present case, there was no surrender invoking the recapture rule because the prosecution history and claim amendments and cancellations fail to support any inference

that original claims 1 and 6 were canceled to overcome a prior art rejection.

The CCPA stated in *Wesseler* that:

[i]nsofar as the act of cancelling claims is concerned the record does not show whether this was an admission that those claims were unpatentable over the prior art or whether they were cancelled and the amended claims were submitted to cure the 'vague and indefinite' rejection. *Id.*, at 345, 346.

Similarly, the record of the present application provides no indication that the cancellation of claims 1 and 6 was due to the prior art rejection or due to the "vague and indefinite" rejection. Given that the CCPA's decision in *Wesseler* is binding legal precedent for the present situation, the law applied to the *Wesseler* situation should be similarly applied to the present situation.

Similarly to *Wesseler*, *In re Petrow*, 159 USPQ 485 (CCPA 1968), stated that where the deliberate cancellation of a claim does not amount to an admission that the reissue claims were not patentable at the time the original claims were canceled, there is no surrender and no recapture estoppel. The court stated:

There are not sufficient facts in the record to base a holding that the cancellation of claim 4 was in any sense an admission, the applicant amended the claims to put claims in proper form under a 112 product by process claim. *Petrow* at 450-451.

Thus, *Wesseler* and *Petrow* stand for the proposition that the recapture rule does not apply absent evidence that applicant's amendment was an admission that the scope of that claim was not in fact patentable over the prior art.

Here, the Office Action does not even assert that the cancellation of claims 1 and 6 was to overcome the prior art.

Here, similarly to *Wesseler*, the cancellation of claims 1 and 6 and the amendments to the allowable claims were done in order to present the claims in a form to allow the invention to be understood, in view of the indefiniteness rejection.

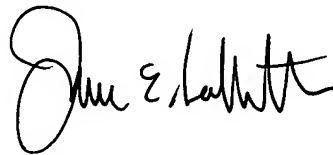
Thus, under the principles of *Wesseler* and *Petrow*, there was no surrender invoking the recapture rule in the present case, because the prosecution history and claim amendments and cancellations fail to support any inference that original claims 1 and 6 were canceled to overcome a prior art rejection.

For the foregoing reasons, withdrawal of the rejection of claims 25-28 under 35 U.S.C. §251 as allegedly being an improper recapture of broadened subject matter is respectfully requested.

It is submitted that this application is now in condition for allowance, and a notice to that effect is respectfully requested.

If any issue remain which may best be resolved through a telephone communication, the examiner is requested to telephone the undersigned at the local Washington, D.C. telephone number listed below.

Respectfully submitted,



Date: March 23, 2005

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